

REQUEST FOR RECONSIDERATION WITH AMENDMENT

During a telephone conversation with Examiner Gart, Applicant demonstrated the use of this invention by directing the Examiner to www.CiteTheLaw.com on the Examiner's own computer and then performing a live demonstration of the invention. Examiner Gart acknowledged the tangible existence and usefulness of the invention. With the Substitute Specification and New Claims, Applicant believes the rejection under 35 USC § 101 should now be withdrawn. The invention is far from an abstract idea. It functions daily in the real world.

Claim Rejections – 35 USC § 102**I. Walker Does Not Anticipate, Describe Or Patent The Invention**

For the reasons set forth below, the New Claims now make clear that the invention was not anticipated, described or patented by Walker U.S. Patent No. 5,862,223.

A. Walker Does Not Anticipate Or Describe The Standardization Or Automation Of Expert Job Requests Or Expert Job Pricing

Walker states in Claim 1 that it is an invention “for *managing communications* between an expert having particular qualifications and an end user seeking a solution to an end user request”. Claim 1, Column 40, lines 55-57 (emphasis added).

Walker Column 7, lines 5-30; Column 21, lines 12-26; Columns 17, 19 and 20; and Figures 8 and 15 outline an apparatus for an end user to identify a category and subcategory of expert types (e.g., category = physician; sub-category = ophthalmologist) and to *manually* devise a job request and job specifications with a *manually stated* range of money the end user is willing to pay to have the expert perform the job. The end user then submits this job request and price range to the invention and waits to receive bids

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from experts in the database. If an expert in the database is interested in the job, he/she **manually** determines the amount of money to bid on the job and then submits this to the invention for transmission to the end user. The expert and end user then further negotiate the terms **manually** and, when a deal is reached, an electronic acceptance is exchanged. In other words, Walker creates a means for experts and their clients to communicate **manual** job requests and to make and accept **manual** bids via computer rather than telephone or postal mail.

Walker is clear that the invention **does not anticipate or make any claim of a means for standardizing or automating the job requests themselves, or of standardizing and automating the pricing of job requests.** This is a critical distinction. Job requests and specifications under Walker are typed into the Walker “communications system” in the user’s own words. No standardization or automation of the job specifications is provided by the invention. In other words, no standardized set of instructions or specifications that could automate the job request process are anticipated or offered by the Walker invention. As it states on its face, Walker is merely a “communications system” under which an end user must define the job request and specification manually and only then submit them to the invention. Likewise, the experts under Walker must manually review the job requests and then manually calculate and submit a bid to do the work – Walker does not suggest any way of standardizing or automating the pricing of job requests. Further negotiation takes place between the expert and user, and finally a deal is reached. **Under Walker, the entire job request process, and the entire job request pricing process, is performed manually by the user and the expert – not by the invention itself.** Again, as Walker states repeatedly, the invention is simply a means

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for the expert and the user to “communicate” with each other their manually defined job requests and bids – without standardization or automation of job requests or pricing.

B. The New Claims Describe An Invention For The Standardization And Automation Of Legal Research Job Requests And Job Pricing

In stark contrast to Walker, the New Claims here describe an invention for standardizing and automating the assignment, valuation, pricing and purchasing of legal research projects. Set forth below is New Claim No. 22 in its entirety. The material portions of the claim that have not been anticipated in any way by Walker have been highlighted for ease of comparison:

What is claimed is:

22. An apparatus for standardizing and automating the assignment, valuation, pricing and purchasing of legal research projects, comprising:

an electronic legal research ordering and pricing server connected through a network to a legal research provider using a computer, a legal research acquirer or purchaser using a purchaser client, and a settlement organization;

means of receiving and storing in a database standardized primary legal research instructions and specifications, standardized secondary legal research instructions and specifications, and standardized specific legal research instructions and specifications;

means of receiving and storing in a database numerical complexity values assigned to each standardized primary, secondary and specific legal research instruction and specification;

means of receiving and storing in a database standardized price ranges assigned to said numerical complexity values;

means of receiving and storing in a database standardized delivery time and means options and prices assigned to said delivery time and means options;

means of receiving display request information from a purchaser client and generating, organizing and displaying to the purchaser client the stored standardized primary, secondary and specific legal research instructions and specifications and the standardized delivery time and means options;

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means of receiving and storing in a database the **standardized primary, secondary and specific legal research instructions and specifications and standardized delivery time and means options** selected by said purchaser client when making a legal research assignment, including a statement of the issue to be researched;

means of **automatically calculating the total value for a legal research assignment made by said purchaser client** by accessing and totaling the stored **numerical complexity values** assigned to each stored legal research instruction and specification option selected by said purchaser client;

means of **automatically calculating an interim price** for the legal research assignment placed by the purchaser client by accessing and identifying the stored price range that corresponds to the stored **total numerical complexity value** for the legal research assignment made by the purchaser client;

means of **automatically calculating the final price** of the legal research assignment placed by the purchaser client by adding to or deducting from said interim price the **stored price for the standardized delivery time and means options** selected by said purchaser client;

means of generating, organizing and displaying to the purchaser client a summary of the **standardized legal research instructions and specifications** and the **standardized delivery time and means options** selected by said purchaser client, together with the said **automated final price** for the legal research order;

means of receiving input and authorization from said purchaser client to finalize and place said legal research assignment order, and means for receiving and storing the purchaser's identification and transaction information;

means of requesting a settlement organization connected to the network to complete the initiated transaction;

means of generating and conveying to a legal research provider for each legal research assignment a summary of the **standardized legal research instructions and specifications selected by the purchaser client, the standardized delivery time and means options** selected by the purchaser client, the legal issue stated by the purchaser client, the **automated final price** for each order and customer and payment information, so the order can be fulfilled.

The highlighted text above readily distinguishes the invention claimed in the instant Application from the Walker patent or anything that can be anticipated by the

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Walker patent. This same reasoning and analysis distinguishes all remaining New

Claims in the Substitute Specification from Walker.

Simply put, until creation of the invention described in the Amended Application, no apparatus has existed for standardizing highly complex legal research instructions and automating the assignment and pricing of legal research projects. Walker makes no attempt to do so, nor does it suggest that such a feat is even remotely possible or anticipated. The invention described is thus a dramatic advancement in the technological arts, making it possible for the first time to automate the assignment and valuation of legal research projects. This is fully articulated in the Substitute Specification and New Claims. The invention can be seen in action at www.CiteTheLaw.com.

In summary, Walker does not anticipate, describe or patent the invention. Therefore, it cannot be a basis for rejecting the claims under 35 USC § 102.

II. Usitalo Cannot Be Invoked Under 35 USC § 102, Nor Does It Anticipate Or Describe The Invention

The Application in question here was first filed in provisional form on March 14, 2001, and then in non-provisional form on June 12, 2001. By contrast, Usitalo Patent Application U.S. 2002/0099679 was first published on *July 25, 2002 – more than one year after both the provisional and non-provisional filing dates of the Application in question here*. 35 USC § 102 provides that a person is entitled to a patent unless the invention “was patented or described in a printed publication in this or a foreign country .

.. more than one year prior to the date of application for patent in the United States.” 35 USC § 102 (emphasis added). Since the Usitalo application was not published until more

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than one year *after* the filing of the Application at issue here, it cannot, as a matter of law, be invoked to reject the Application under 35 USC § 102.

Moreover, Usitalo does not in any way anticipate, describe or seek to patent the invention here. Like Walker, Usitalo does not discuss the standardization or automation of expert job requests or expert job pricing. To the contrary, Usitalo is merely a “system for creating a user workflow” that extracts knowledge from existing databases of expert knowledge. *See* Usitalo Claim 1. Usitalo does not purport to create a system for communication between experts and people requesting customized expert analysis, let alone a system for standardizing and automating the ordering and pricing process.

In summary, as a matter of law and fact, Usitalo cannot be the basis for rejecting the Application here under 35 USC § 102.

III. Sinton Cannot Be Invoked Under 35 USC § 102, Nor Does It Anticipate Or Describe The Invention

For the same reasons as Usitalo set forth above, the newspaper article by Peter Sinton entitled “Two Attorneys Hang Their Shingles Online,” San Francisco Chronicle (August 2, 2000), cannot be a basis for rejecting the Application here under 35 USC § 102. The Sinton article was published on August 2, 2000 – slightly more than 7 months prior to the filing of the provisional Application here (March 14, 2001) and slightly more than 10 months prior to the filing of the non-provisional Application (June 12, 2001). A prior publication can be invoked to reject a patent application under 35 USC § 102 only if publication was made “more than one year prior to the date of the application.” 35 USC § 102. Sinton was published only 7 months prior to the date of the Application here.

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Therefore, it cannot, as a matter of law, be invoked to reject the Application under 35

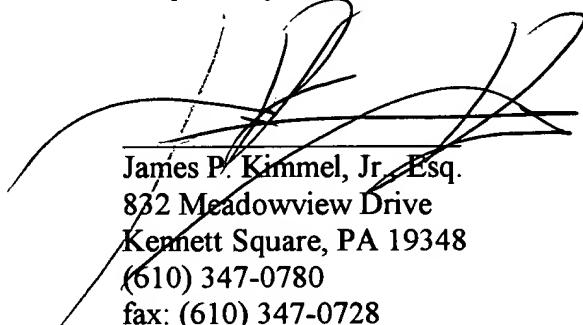
USC § 102.

Additionally, Sinton does not describe or disclose a system for standardizing and automating the ordering and pricing of legal research. At most, it can be said to disclose a simple online market place for the advertising legal research – in other words, an internet portal where attorneys can go to find the names of people or companies that provide legal research. No mention is made in Sinton of a way of standardizing or automating the purchasing of legal research.

CONCLUSION

For the forgoing reasons, Patent Application No. 09/879,224 should be granted forthwith.

Respectfully submitted,



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